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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,711	02/07/2001	Tomoji Asada	450100-02994	4182
20999	7590	12/01/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			BOCCIO, VINCENT F	
		ART UNIT	PAPER NUMBER	
		2621		
DATE MAILED: 12/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/778,711	ASADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vincent F. Boccio	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on RCE of 9/15/06 and amendment of 8/21/06.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2621.

***Response to Arguments***

1. Applicant's arguments filed 8/21/06 have been fully considered but they are not persuasive and further the examiner has new ground(s) of rejection, after a careful analysis and will answer relevant arguments based on the references used.

{A} In re page 12, applicant states, the references of record fails to teach, disclose or suggest, "... determining whether or not a program being received is copy protected on the Basis of ECM, EMM, as recited in claim 1".

In response Kim teaches this limitation, in view of Fig. 5 for example, when copy protected (ECM & EMM and CA data are required to view or render, also see Fig. 12, "120, ECM, EMM", "124, this step determines whether to allow recording), therefore deemed that the system determines whether a program being received is copy protected in view the decision steps based on the information (EMM, ECM, used and associated with CA from a smart card or other source to generate the Key, therefore copy protected, but, can be recorded, based on the determination made step 124 or Fig. 10 step 115, even Figs. 4-5, col. 3, "prohibit copying ...").

{B} In re page 13, applicant states, the prior art of record fails to teach, disclose or suggest, wherein the ECM & EMM and descramble Key, are simultaneously supplied to a descrambler.

In response the examiner cites Fig. 5, descrambler systems and/or elements are met by the combination of (37 & 29), after reception (28), and processing of ECM & EMM & CA (extraction), to generate CW, the CW is supplied as illustrated, to 29 the descrambling element, the signals are required to be at the same time or simultaneously (ECM & EMM & CA) to generate CW, without CW cannot be generated, as understood.

Signals ECM & EMM & data of Smart Card key data, from 38 are deemed to be required to be provided or presented at the same time to (the combination of {37 & 29} or the descrambler), to generate the CW to descramble at 36, or the CW cannot be properly generated without the necessary signals, thereby

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presented at the same time, as required, or signal CW cannot be generated because, the CW is based on having ECM & EMM and CA to generate CW, therefore are required to be presented at the same time to generate a valid CW, to the descrambler element 29 to descramble.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kim et al. (5,799,081) in view of Liebenow et al. (6,601,074).

Regarding claims 1, 5, 7, 11, 13 and 17, Kim discloses and meets the limitations associated with an apparatus, system and control method, wherein the receiving device/system (such as Figs. 4, 5, 10, 12, etc.....) comprises:

- monitor/display device (Display for displaying RF NTSC output,  
Fig. 4);

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- external recording device (VCR or DVCR);
- control means (Fig. 10);
- determining whether or not a program being received is copy protected (Fig. 5, based on, "ECM & EMM & CA", scrambled, "means it is copy protected"), or Fig. 10, descrambled means it is copy protected);
- setting the external to a recording state (event) if the program is initially found not copy protected and disabling recording, if found to be protected or no copies allowed (copying may be allowed for one copy or not, col. 6, lines 7-18, "permissible generational field ... or copying is impossible", Fig. 6 A, "permissible generational field"), wherein the external device is or can be prevented based in the (EMM & ECM & CA, analysis to generate a key or not); and
- further all information (EMM & ECM & Smart & Card Data CA) are required simultaneously or at the same time, to create CW or the Key.

The ECM & EMM and data from the smart card, the 3 pieces of data, from these sources, is required to generate the Key, when the key is generated it means that all data required was simultaneously applied to descrambler components (Fig. 5, descrambler combination of 37 & 29).

Kim fails to particularly disclose on-screen display or EPG, for displaying a screen corresponding to various setting states and arranging items (claims 1, 7, 13) in the screen and external device control means for setting, such as a A/V mouse, claims 1, 5, 7, 11, 13 and 17.

Liebenow teaches that the program can be requested for recording using the electronic program guide (EPG) setting and arranging items for recording for example (see Fig. 2, col. 3, lines 18-39 and from col. 4, line 66 to col. 5, line 57) and further teaches the use of various user controls or user input device or means (Fig. 1, "mouse 150 or others 145, even 160").

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of requesting a program to be recorded by using EPG

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in the display and to use a mouse to control and set events, as taught by Liebenow, in order to simplify and enhance the ease of use, setting programs events for recording using a mouse and EPG on the display.

Regarding claims 2-4, 8-10 and 14-16, the combination as applied fails to address,

- when the program is found to be copy protected when recording input is given a warning indicative of copy protection is displayed;
- when, recording input is given (system triggers, a recording operation, based on an event set), an on-screen display for stopping recording is given and
- when the recording input is given, providing an on screen display for stopping recording.

The examiner takes official notice that it is well known to provide warnings as on-screen displays indicating copy protection or availability of program for recording or not, based on copy protection, to provide on-screen controls such as stop button control controlling stopping of recording and enabling to a selected state (operable, when recording to stop the operation), therefore, it would have been obvious to those skilled in the art at the time of the invention to provide on-screen displays corresponding to warnings, controlling stopping of recording and/or putting a stop button into a selected state, "operable" for stopping during recording to stop recording, thereby enhancing user system operations, by providing additional operator information on an on-screen display to the user thereby enhancing ease of operation for users.

Regarding claims 6, 12, 18, the combination as applied fails to particularly disclose wherein the external device control means controls the external recording device by using an IEEE 1394 interface.

The examiner takes official notice that IEEE 1394 interface is well known that is used for transferring by interfacing with various devices to transfer data and control devices, wherein the 1394 interface can transfer and controls bi-directionally, as is well known in the art.

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Therefore, it would have been obvious to those skilled in the art at the time of the invention to modify the combination by utilizing IEEE 1394 interfaces between the recording device and system to control, as well as transmit Video-Audio streams as well, which is a universal serial bus type digital interface (IEEE 1394), in view of being capable, widely used, versatile, available, as is well known and obvious to those skilled in the art.

**Contact Fax Information**

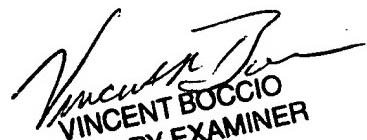
Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry,  
this Central Fax Number as of 7/15/05

**Contact Information**

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent  
11/27/06



VINCENT BOCCIO  
PRIMARY EXAMINER